



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,481	11/10/2003	Sonya S. Johnson	112703-306	5154
29156 7590 08/05/2009				
K&L Gates LLP				
P.O. Box 1135				
CHICAGO, IL 60690				
EXAMINER				
ROBERTS, LEZAH				
ART UNIT		PAPER NUMBER		
1612				
NOTIFICATION DATE		DELIVERY MODE		
08/05/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

### Office Action Summary

**Application No.**

10/705,481

**Applicant(s)**

JOHNSON ET AL.

**Examiner**

LEZAH W. ROBERTS

**Art Unit**

1612

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 7-11, 14, 18-21 and 24-33 is/are pending in the application.
- 4a) Of the above claim(s) 21 and 24-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 7-11, 14, 18-20 and 27-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

Applicants' arguments in the Appeal Brief, filed April 30, 2009, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claims***

#### **Claim Rejections - 35 USC § 112 – Written Description (New Rejection)**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 4, 7-11, 14, 18-20 and 27-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite a "cooling agent" and the instant specification defines "cooling agent" as a "non-menthol cooling agent". The specification further discloses that the cooling agents used in the

Art Unit: 1612

instant invention may be chosen from "menthol, menthol glyceryl ether, N,2,3-trimethyl-2-isopropyl-butanamide and menthyl glutarate or combination thereof (page 4, lines 3-5). The term "cooling agent" lacks "Written Description" because it is specifically defined as not being a menthol and then is disclosed as encompassing menthol, which makes the term confusing and contradictory.

**Claim Rejections - 35 USC § 112 – Indefiniteness (New Rejection)**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4, 7-11, 14, 18-20 and 27-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) The claims recite "an effective amount of menthol, a cooling agent and a heating agent". The phrase is indefinite insofar as it is unclear if "effective amount" encompasses only the amount of "menthol" or if it encompasses "menthol, a cooling agent and a heating agent" combined. It is also not clear what "menthol" or the combination of "menthol, a cooling agent and a heating agent" are effective for, such as for an antimicrobial effect or and an improved flavor experience.

2) The claims recite "cooling agent" and the specification defines "a cooling agent" as "non-menthol cooling agents" (page 1, lines 20 and 21). The instant

specification further discloses a cooling agent is chosen from "menthol, menthol glyceryl ether...". The term "cooling agents" has conflicting definitions and is therefore indefinite insofar as it is unclear whether "cooling agents" encompass menthol or not.

**Claim Rejections - 35 USC § 103 – Obviousness (Previous Rejection)**

Claims 1, 4, 7-11, 14, 18-20 and 27-33 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kumamoto et al. (US 2002/0119231) in view of Sturtz (US Plant 8,645). The rejection is maintained.

**Applicant's Arguments**

Applicant argues that the combination of Kumamoto et al. and Sturtz do not disclose or suggest every element of the presently pending claims. The combination recited in the instant claims provides a novel flavor and reduces the cost of peppermint flavored products. The reference also fails to disclose menthol in an "effective amount". Sturtz discloses Erospicata oil contains 0.05% menthol and not 1% menthol. This amount is not effective within in the meaning of the present claims. Further Sturtz is directed to as low as a menthol content possible and would not include an effective amount of menthol. Kumamoto et al. fail to disclose using a combination of menthol and a non-menthol cooling agent. The references also fail to disclose an oral product comprising Erospicata at a concentration ranging from about 0.01 to about 5% by weight of the total product. Nowhere in Sturtz or Kumamoto et al. does it disclose that Erospicata oil is used to achieve a novel flavor when combined with a cooling agent.

Art Unit: 1612

Sturtz merely discloses that Erospicata oil has a characteristic peppermint taste and smell. Sturtz also teaches away from the instant claims and Kumamoto et al. because it teaches menthol is undesirable in ingestible products. Thus, one of skill of the art would not add additional menthol and the menthol contained in the Erospicata oil is not an effective amount. Because Sturtz does not teach how much is too much menthol and teaches that menthol causes nasal and gastrointestinal irritation, one would not be motivated to add any menthol to oral compositions. These arguments are not persuasive.

#### Examiner's Response

The Examiner asserts that the combination of references suggest every element of the pending claims because Kumamoto et al suggest using a combination of a cooling agent and a warming agent in compositions with a peppermint flavor and Sturtz provides motivation of why one of skill in the art would want to use Erospicata oil as a peppermint flavor. The compositions of Kumamoto provide the teaching of a "novel flavoring" because the flavoring having a warming effect is the disclosed invention. In regards to the "effective amount", there appears to be no indication in the instant specification of what encompasses an "effective amount" or what the menthol is effective against. Sturtz discloses menthol is present in the Erospicata oil and comprises a maximum of 1% of the oil. Although there is no example disclosed by the reference that the oil comprises about 1%, the reference does teach that the oil

Art Unit: 1612

comprises more than 0.05% by its disclosure of menthol comprising 0.17% by weight (see Table 2). This shows that the amount of menthol may vary. Although Sturtz teaches the absence of menthol avoids irritation to the oral and nasal cavities, the oil itself comprises menthol and therefore meets the limitations of the instant claims, considering it is not disclosed what "an effective amount" encompasses (see Indefiniteness Rejection above). Further, Sturtz provides several reasons why one would use Erospicata oil, the first, to avoid too much menthol when this is desired and second, to avoid the bitter taste due to piperitone when this is desired. When certain amounts of menthol and a strong peppermint taste without the bitter taste of piperitone are desired, one of skill in the art would be motivated to use Erospicata oil to avoid the bitter taste. Also since it is disclosed in the art that menthol is an agent used separate from peppermint, as disclosed by Kumamoto, it would have been reasonable for one of skill in the art to add an "effective amount" of menthol dependent on its desired function.

In regards to the amount of Erospicata oil, the oil provides flavoring to the compositions and therefore it would have been taken no more than the relative skill of one of ordinary skill in the art to have adjusted the amount of Erospicata oil in the flavor composition motivated by the desire to achieve optimum flavor in the oral composition.

Claims 1, 4, 7-11, 14, 18-20 and 27-33 are rejected.

Claims 21 and 24-26 are withdrawn.

No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEZAH W. ROBERTS whose telephone number is (571)272-1071. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick F. Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lezah W Roberts/  
Examiner, Art Unit 1612

/Frederick Krass/  
Supervisory Patent Examiner, Art Unit 1612